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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,920	12/24/1998	JEFFREY D. MILBRANDT	6029-7996	5436

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EXAMINER

MURPHY, JOSEPH F

ART UNIT

PAPER NUMBER

1646

20

DATE MAILED: 12/26/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/220,920	MILBRANDT ET AL.
	Examiner Joseph F Murphy	Art Unit 1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 October 2001 .

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,11,12,15-27,39 and 40 is/are pending in the application.

4a) Of the above claim(s) 1 and 11 is/are withdrawn from consideration.

5) Claim(s) 12,25,27 and 39 is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) 15-24, 26, 40 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Formal Matters***

Claims 12, 15, 25 and 27 were amended in Paper No. 18, 10/15/2001. Claims 1, 11-12, 15-27, 39-40 are pending. Claims 1 and 11 stand withdrawn from consideration pursuant to 37 CFR 1.142(b). Claims 12, 15-27, 39-40 are under consideration.

### ***Response to Amendment***

The rejection of claims 12, 25 and 39 under 35 USC § 101 was obviated by Applicant's amendment and is thus withdrawn.

The rejection of claims 12, 15-26, 39-40 under 35 USC § 112, first paragraph, for recitation of "fragments" has been obviated by Applicant's amendment, and is thus withdrawn.

The rejection of claims 12, 15-27, 39-40 under 35 USC § 112, first paragraph, for recitation of "65%" has been obviated by Applicant's amendment, and is thus withdrawn.

The rejection of claims 12, 15-27, 39-40 under 35 USC § 112, first paragraph, as lacking written description for a nucleic acid encoding an amino acid which is 65% identical to SEQ ID NO: 26 has been obviated by Applicant's amendment, and is thus withdrawn.

### ***Claim Objections***

Claims 23-24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 15 is drawn to an isolated nucleic acid encoding an amino acid sequence at least 88% identical to SEQ ID NO: 26. Dependent claims 23-24 fail to further limit claim 15 by encompassing polynucleotides encoding SEQ ID NOs: 40, 32, 41, and 29.

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This fails the infringement test set forth in MPEP 608.01(n), which is that the dependent claim shall not conceivably be infringed by anything which would not also infringe the base claim.

Since the encoded polypeptide sequences in claim 23-24 are about 88% identical to the encoded SEQ ID NO: 26, it would be possible for a polynucleotide to infringe a polynucleotide encoding SEQ ID NO: 40, 32, 41 or 29 without infringing a polynucleotide encoding SEQ ID NO: 26.

Claims 15-24, 26, 40 are objected to because of the following informalities: Claim 15 recites "artemin amino acid promotes survival of neurons", the word "sequence" should be added after "amino acid". Claims 16-24, 26 and 40 are objected to based on their dependence on claim 15. Appropriate correction is required.

*Conclusion*

Claims 12, 25, 27 and 39 are allowable.

Claims 15-24, 26, 40 are objected to.

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
December 20, 2001



YVONNE EYLER, PH.D  
SUPERVISORY PATENT EXAMINER  
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